



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/089,871	06/04/1998	RUDOLF CAROLUS MARIA BARENDSE	97253-A	3289

25225 7590 06/03/2004
MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

EXAMINER

RAMIREZ, DELIA M

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/089,871

Applicant(s)

BARENDSE ET AL.

Examiner

Delia M. Ramirez

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 May 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): see attached.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 18-28,31-35,39-40.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Art Unit: 1652

ADVISORY ACTION

1. Claims 18-28, 31-35, and 39-40 are pending.
2. The terminal disclaimer filed on 5/4/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6500426 has been reviewed and is accepted. The terminal disclaimer has been recorded. In view of the submission of this terminal disclaimer, the obviousness-type double patenting rejection previously applied to claims 18-23, 31-35 and 39-40 is hereby withdrawn.
3. The request for reconsideration filed on 5/4/2004 under 37 CFR 1.116 in reply to the Final Action Paper No. 33 mailed on 11/03/2003 has been considered but it is not deemed sufficient to place the application in condition for allowance for the following reasons.
4. Applicants submit that the specification, specifically Examples 5 and 10, demonstrate that the phytase in feed prepared with the high phytase granulate has much higher pelleting stability than phytase in feed prepared using granulates made with an aqueous solution with a lower phytase concentration. Applicants further argue that a prima facie case of obviousness has not been established. According to Applicants, Nielsen does not teach or suggest the granulates or compositions claimed and neither Ghani, Markussen or Haarasilta cure the deficiencies of Nielsen.
5. Applicant's arguments have been fully considered but are not deemed persuasive to overcome the rejections. The Examiner agrees that the results disclosed in the specification appear to suggest increasing pelleting stability with increasing phytase concentration of the granulates. However, as indicated before in Paper No. 33 in reference to Example 5, while the results disclosed in the specification appear to indicate that increasing the phytase concentration in the granulates may result in increasing pelleting stability, there is no teaching or suggestion in the specification indicating that the phytase concentration of the liquid used in making the granulates have an effect on pelleting stability. In fact, the specification in page 19, lines 23-25 indicates that the two granules with the highest enzyme

Art Unit: 1652

concentration had much higher pelleting stability. For example, there is no disclosure of several sets of granulates having 6830 FTU/g (sample C in Table 2) each made with liquid phytase solutions of different concentrations and having different pelleting stability. Similarly, Example 10 while also suggesting that the concentration of phytase in the granulate is important in pelleting stability, does not suggest that the concentration of phytase in the liquid solution used to make the granulates is relevant to pelleting stability. Thus, there is no evidence that the granulate of Nielsen et al., which contains at least 6000 FTU/g is any different from a granulate having at least 6000 FTU/g made with an aqueous liquid comprising a phytase at a concentration of at least 14000 FTU/g liquid. Since it has not been established that the concentration of phytase in the liquid used to make the granulates is a factor which would render unexpected results regarding pelleting stability, the teachings of Nielsen, Ghani, Markussen and Haarasilta render the claimed invention obvious for the reasons of record.

6. For purposes of Appeal, the status of the claims is as follows:

Claim(s) allowed: NONE

Claims(s) objected to: NONE

Claim(s) rejected: 18-28, 31-35, 39-40

Claim(s) withdrawn from consideration: NONE

7. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 872-9306. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.


Art Unit: 1652

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (571) 272-0928. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
May 26, 2004


REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP 1800-
1600